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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/609,303	06/30/2000	Paul Lapstun	NPA050US	2504
24011	7590	01/25/2006		
SILVERBROOK RESEARCH PTY LTD 393 DARLING STREET BALMAIN, NSW 2041 AUSTRALIA			EXAMINER COLIN, CARL G	
			ART UNIT	PAPER NUMBER
			2136	

DATE MAILED: 01/25/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/609,303

Applicant(s)

LAPSTUN ET AL.

Examiner

Carl Colin

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 10 November 2005.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-34 and 39-42 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-34 and 39-42 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 30 June 2000 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. §§ 119 and 120**

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) see att. 6) ☐ Other: \_\_\_\_\_

## **DETAILED ACTION**

### ***Continued Examination Under 37 CFR 1.114***

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 11/10/2005 has been entered.

### ***Response to Arguments***

1.1 In response to communications filed on 11/10/2005, applicant amends claims 1, 13, 24, and 30, and adds claims 39-42. The following claims 1-34 and 39-42 are presented for examination.

1.2 In response to communications filed on 11/10/2005, the amendment to the specification has been considered and the rejection has been withdrawn.

1.3 Applicant's arguments, pages 13-15, filed on 11/10/2005, with respect to the rejection of claims 1-34 have been fully considered, but they are not persuasive as explained previously in the advisory action. Applicant has amended the claims to incorporate in the independent claims the limitations of the cancelled claims and new claims with new limitations have been added. Upon further consideration, a new ground of rejection is made.

***Claim Objections***

2. Claim 39 is objected to because of some of typographical errors on the first sentence. Appropriate correction is required.

***Claim Rejections - 35 USC § 112***

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter, which the applicant regards as his invention.

Claims 1, 13, 24, and 30 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

- 3.1 Regarding claims 1, 13, 24, and 30 the phrase "indicating data that includes time varying position information regarding movement of the sensing device relative to the form generated by the sensing device during operation thereof using sensed coded data" should be corrected for example "using sensed coded data" should be replaced with "using coded data" to remain consistent with the specification because the information is generated using at least some of the coded data on the form.

***Double Patenting***

4. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or

improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 1, 13, 24, and 30 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims of copending Application No. 10/291,821. Although the conflicting claims are not identical, they are not patentably distinct from each other because Application No. 10/291,821 of claim 1, for instance discloses receiving, in a processing system associated with the computer system, indicating data from a sensing device regarding movement of the sensing device relative to the form and the indicative data being generated using at least some of the sensed coded data. It is obvious that if the indicating data represent data relative to movement, the movement can be measured according to time and distance. Therefore, the difference of "indicating data includes time-varying position information" is not a patentably distinct variation.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

***Claim Rejections - 35 USC § 103***

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5.1 **Claims 1-10, 12-22, 24-28, 30-33, and 39-42** are rejected under 35 U.S.C. 103(a) as being unpatentable over US Patent 6,081,261 to **Wolff et al.** in view of US Patent 5,477,012 to **Sekendur** and in view of US Patent 4,864,618 to **Wright et al.**

5.2 **As per claims 1, 13, 15, and 39-42, Wolff et al** discloses a method and system for enabling registration of a user to use a computer system, the method including: receiving, in a processing system associated with the computer system, indicating data from a sensing device regarding the identity of the form and a position of the sensing device relative to the form, the sensing device, when placed in an operative position relative to the form, generating the

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indicating data using at least some of the coded data on the form, for example (see column 9, line 39 through column 10, line 34; and column 6, lines 59 et seq.); and identifying, in the processing system and from the indicating data, at least one parameter relating to user registration, and storing the at least one parameter so as to be accessible by said computer system, for example (see column 6, lines 59 et seq. and see column 9, line 39 through column 10, line 38); providing a printed registration form containing information relating to user registration, the form including coded data indicative of an identity of the form and of at least one reference point of the form, for example (see column 9, line 64 through column 10, line 9; column 3, lines 25-40; and column 4, lines 7-37 and lines 52-58). **Wolff** discloses data identifying position location with respect to the form, by reciting a pen instrument having sensors capable of reading digitally encoded and printed information and support at least Optical character recognition, also the pen instrument can have receiver for receiving output of multiple (infrared) transmitter for position location of the writing surface, see column 9, lines 1-28 and column 10, lines 46-50. To one skilled in the art it is obvious that the recitation of coded data identifying a unique location of points relative to the form does not depart from the spirit and scope of the invention of **Wolff**. **Wolff et al** does not explicitly disclose the sensing device generating indicating data that includes time varying position information regarding movement of the sensing device relative to the form using sensed coded data. It is noted that the scanned coded data can be interpreted as sensed coded data because they have to be sensed by sensors or readers. **Sekendur** in an analogous art teaches providing a surface paper with position-related coding means having a plurality of reference points or coordinates for designating coordinates relative to the paper, the path of the pen and the writing tip of the pen, for example (see column 4, lines 10-60) that meets the recitation of

providing a form with a plurality of coded data wherein the coded data include coded data portions, each coded data portion being indicative of the at least one reference point of the form and the identity of the form and disclosing indicating data includes time varying position information regarding movement of the sensing device relative to the form generated by the sensing device during operation thereof using sensed coded data for example (see column 4, lines 10-60). The invention discloses many advantages such as a system that indicates precisely the movement and position of a movable element within a plane or a three dimensional element, for example (see columns 2-3). **Sekendur** even suggests that the position-related coding means may comprise of any means even a barcode system (see column 4, lines 45-50). Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to provide a form with a plurality of reference points, the coded data identifying a unique location of each of the reference point relative to the form as taught by **Sekendur** in order to indicate precisely the movement and position of a pen within a plane or a three dimensional element, for example (see columns 2-3); and indicating data that includes time varying position information regarding movement of the sensing device relative to the form generated by the sensing device during operation thereof using sensed coded data in order to indicate precisely the movement and position of a pen within a plane or a three dimensional element, for example (see columns 2-3). This modification would have been obvious because one skilled in the art would have been motivated by the suggestions provided by **Sekendur** so as to benefit from precisely locating the movement and position of a pen within a plane or a three dimensional element, for example (see column 2, lines 45-61 and abstract).



**As per claims 2 and 14, Wolff et al.** discloses the limitation of wherein said at least one parameter relating to the user registration is associated with at least one zone of the form, and wherein the method includes identifying, in the processing system and from the zone relative to which the sensing device is located, said at least one parameter (see column 4, lines 7-37 and column 3, lines 42-65; see also column 9, lines 1-38).

**As per claim 3, Wolff et al.** discloses the limitation of wherein the indicating data includes time-varying position information regarding movement of the sensing device relative to the form which is generated by the sensing device during operation thereof using at least some of the coded data (column 9, lines 1-38 and lines 58-63), and wherein the method includes identifying, in the processing system and from the movement information of the sensing device at least partially within said at least one zone, said at least one parameter (see column 4, lines 7-51). Claim 3 is also rejected on the same rationale as the rejection of claim 1.

**As per claims 4 and 18, Wolff et al.** discloses the limitation of in which the at least one parameter is a text parameter of the user registration, the method including identifying, in the processing system, that said movement information of the sensing device represents an action of entering handwritten text data by means of the sensing device and effecting, in the processing system, an operation associated with the text parameter (see column 4, lines 7-12 and lines 52-67 and column 8, lines 48-67)

**As per claims 5 and 19, Wolff et al.** discloses the limitation of including converting, in the processing system, the identified handwritten text data into computer text (see column 7, lines 6-14 and column 6, lines 31-45).

**As per claim 6, Wolff et al.** discloses the limitation of wherein the at least one text parameter comprises registration data identifying said user (see column 3, lines 25-50 and column 8, lines 59-67).

**As per claim 7, Wolff et al.** discloses the limitation of wherein the registration data includes identification and contact details associated with said user (see column 3, lines 25-50).

**As per claim 8, Wolff et al.** discloses the limitation in which the parameter is a user authorization parameter, the method including identifying, in the processing system, that the user has entered a handwritten signature by means of the sensing device and storing data identifying the handwritten signature so as to be accessible by the computer system (see column 8, lines 59-67 and column 7, lines 5-14).

**As per claims 9 and 21, Wolff et al.** discloses the limitation of which includes printing the registration form on demand (see column 6, lines 46-52).

**As per claims 10, 22, 28, and 33, Wolff et al.** discloses the limitation which includes printing the form on a surface-defining means and, at the same time that the form is printed,

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printing the coded data on the surface (see column 1, line 59 through column 2, line 2 and column 3, lines 34-53).

**As per claims 12, 17, and 32, Wolff et al.** discloses the limitation of wherein the sensing device contains an identification means which imparts a unique identity to the sensing device, the method including storing the identity of the sensing device in association with the at least one parameter relating to user registration (see column 10, lines 34-38).

**As per claim 16, Wolff et al.** discloses the limitation of wherein the sensing device includes a marking nib (see column 7, lines 5-14).

**As per claims 20 and 26, Wolff et al.** discloses the limitation of wherein the at least one parameter relating to user registration includes information selected from the group of: identification information for the user; address information for the user; telephone details for the user; and privacy preferences for the user (see column 3, lines 25-50).

**As per claims 24 and 30, Wolff et al.** discloses deriving, from the indicating data regarding at least one action of the sensing device in relation to the form, an identity of a user to be registered (see column 10, lines 34-40); and storing, in the computer system, registration data for the user including the identity of the user associated with the identity of the sensing device (see column 6, lines 59 et seq.; column 9, line 39 through column 10, line 38 and column 10,

lines 34-38). Claims 24 and 30 are rejected on the same rationale as the rejection of claim 1 since the other limitations are found in claim 1 as discussed above.

**As per claims 25 and 31, Wolff et al.** discloses the limitation of wherein the at least one action of the sensing device in relation to the form includes the formation of handwritten text and/or markings on the form (see column 10, lines 34-40).

**As per claim 27, Wolff et al.** discloses the limitation of including receiving in the computer system authorizing data from a second sensing device, the authorizing data including information regarding the identity of the second sensing device, the identity of the form and at least one action of the second sensing device in relation to the form generated by the second sensing device using at least some of the coded data, the second sensing device being associated in the computer system with a second user authorized to permit user registrations (see column 10, lines 34-40). **Wolff et al.** discloses multiple users and sensing device associated with each user. The same invention disclosed can be applied to multiple users.

6. **Claims 11, 23, 29, and 34** are rejected under 35 U.S.C. 103(a) as being unpatentable over US Patent 6,081,261 to **Wolff et al** in view of US Patent 5,477,012 to **Sekendur** and further in view of US Patent 4,864,618 to **Wright et al.**

As per claims 11, 23, 29, and 34, both references substantially disclose the claimed method and system of claims 1, 13, 24, and 30. Neither of the references explicitly discloses printing the coded data to be invisible. However, **Wright et al** discloses the limitation of wherein the information relating to user registration and the coded data are printed simultaneously (column 13, lines 23-31) so that both visible and invisible information can be verified together and non-conformity can be distinguished thereby providing an additional level of security (column 13, lines 32-50). Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the method and system as combined above to provide a printed registration form wherein the registration and the coded data are printed simultaneously and the coded data are invisible so that both visible and invisible information can be verified together and non-conformity can be distinguished thereby providing an additional level of security as taught by **Wright et al**. This modification would have been obvious because one skilled in the art would have been motivated by the suggestions provided by **Wright et al** so as to allow both visible and invisible information to be verified together and non-conformity can be distinguished, thereby providing an additional level of security (column 13, lines 32-50).

### *Conclusion*

7. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure as the art discloses many of the claimed features.

US Patents: 5,247,137 Epperson; 6,088,695 Kara; 5,661,506 Lazzouni et al.

Non-US Patent Publication : WO 9722959 Sekendur.

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7.1 Any inquiry concerning this communication or earlier communications from the examiner should be directed to Carl Colin whose telephone number is 571-272-3862. The examiner can normally be reached on Monday through Thursday, 8:00-6:30 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ayaz Sheikh can be reached on 571-272-3795. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.


Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

*cc*

Carl Colin

Patent Examiner

January 19, 2006

  
AYAZ SHEIKH  
SUPERVISORY PATENT EXAMINER  
TECHNOLOGY CENTER 2100